

REMARKS

Claims 1-22 are pending in this application. By this Amendment, claims 21 and 22 are added. No new matter is added.

I. Personal Interview

Applicants appreciate the courtesies shown to Applicants' representative by Examiner Do in the November 18, 2003 personal interview. Applicants' separate record of the substance of the interview is incorporated into the following remarks.

II. Allowable Subject Matter

Applicants appreciate the indication of allowable subject matter in claims 3-7, 9, 10 and 15-19, they being allowable if rewritten in independent form to include all of the features of their base claim and any intervening claims. Applicants assert that the objected to claims, as well as the rejected claims are allowable for at least the reasons discussed below.

III. Claim Rejections Under 35 U.S.C. §103

Claims 1, 2, 8, 11-14 and 20 are rejected under 35 U.S.C. §103(a) as unpatentable over U.S. Design Patent 413,142 to Pangburn in view of U.S. Patent 6,067,738 to Zeligson. The rejection is respectfully traversed.

In rejecting claims under 35 U.S.C. §103, it is incumbent on the Examiner to establish a factual basis to support the legal conclusion of obviousness. In doing so, the Examiner must provide the factual determinations as set forth in Graham v. John Deere Co., 383, U.S. 1, 17, 148 USPQ, 459, 467 (1966). The criteria set forth in Graham v. John Deere Co. include 1) some suggestion or motivation in either the reference or in the knowledge generally available to one of ordinary skill in the art, to modify the references or combine the teachings; 2) a reasonable expectation of success, and 3) the combination must teach or suggest all of the claim features.

The Office Action admits that Pangburn does not disclose a photo stand, a plurality of engagement portions formed in the outer surface of the printer, wherein the photo stand is

detachably attached to the engagement portions, as recited in claim 1, or the additional features as recited in claims 2-7. Similarly, Pangburn does not disclose or suggest the features recited in claims 8-20.

As discussed during the interview, in making such a combination, the Examiner must provide a reason why one of ordinary skill in the pertinent art would have been led to modify the applied art, or to combine the applied art references to arrive at the claimed invention.

The Office Action alleges that "it would have been obvious to one having ordinary skill in the art at the time the invention was made to have a photo stand and its attached components to attach to not just a printer, but any other appliance as well". The Office Action alleges that the motivation for making the combination is "for the purpose of saving space and individually decorating ideas."

As stated above, the suggestion or motivation to make the combination or modification must come from either the references or the knowledge generally available to one skilled in the art. Pangburn is a design patent that merely provides various perspective views of a printer. Thus, Pangburn offers no motivation or suggestion for combination with any other device. In Zeligson, a refrigerator display lens is disclosed. The problem being addressed in Zeligson is the messy disorganized appearance of refrigerator doors. The proposed resolution to the problem is to provide an improved refrigerator door suited to the neat and organized display of personally selected printed materials and information (col. 1, lines 9-25 of Zeligson). Thus, as discussed during the interview, the motivation for combining is not suggested in either of the applied references.

Furthermore, neither of the applied references addresses the problem being addressed in the application. In the application, the problem being addressed is the limitation of desktop work space due to computer components such as a keyboard, a mouse, documents, and paperwork, and the limitation on space for displaying personal photographs. To overcome the

problem, a printer with a photo stand detachably attached to the printer is disclosed, therefore avoiding the necessity of additional desk space for photo stands. Pangburn is silent regarding a problem being solved and Zeligson is attempting to organize items on a freezer door. Thus, there is no motivation for making the combination as proposed in the Office Action.

Additionally, the mere fact that the references may be modified in the manner suggested by the Examiner, does not make the modification obvious unless the applied art suggests the desirability of such a modification. The references must provide some teaching whereby the combination would have been obvious. It is impermissible for an Examiner to engage in hindsight reconstruction of the claimed invention using the claimed structure as a template, and selecting elements from references to fill the page. In re: Gorman, 911 F2d 982, 986, USPQ2d 1885, 1888 (Fed. Cir. 1991). Applicants assert that because the prior art does not suggest a desirability of such a modification, that it would not have been obvious to one of ordinary skill in the art at the time the invention was made to combine Pangburn with Zeligson without the impermissible use of hindsight. Accordingly, the Office Action has failed to meet the first factor of the factors set forth in Graham v. John Deere Co..

Even were such a combination made, there would be no reasonable expectation of success from the combination. For example, Zeligson does not disclose a photo stand, but rather merely discloses a transparent lens 71 having a hinge 73, and a plurality of orthogonal surfaces 75 that are integrally formed with the lens 73 that wrap around the freezer door 70. Combining the transparent lens with the printer of Pangburn would provide no reasonable expectation of success without further experimentation. Thus, the Office Action has failed to meet the second criteria set forth in Graham v. John Deere Co..

Additionally, as discussed during the interview, even were the combination made as suggested in the Office Action, each and every feature would not be disclosed or suggested in the alleged combination. For example, the combination would not disclose or suggest a printer with

a photo stand that prints indicia on a recording medium, comprising a plurality of engagement portions formed on the outer surface of the printer, wherein the photo stand is detachably attached to the engagement portions.

The Office Action alleges that Zeligson shows a photo stand in Figs. 3-5. However, Zeligson merely discloses a hinged plastic lens that is attachable to a freezer door for the purpose of covering display items attached to the freezer door. The Office Action further alleges that the hinge 73 shown in Fig. 4 of Zeligson corresponds to a plurality of engagement portions, as recited in claim 1. However, as recited in claim 1, the plurality of engagement portions are formed in the outer surface of a printer, whereas the hinge 73 connects the lens 71 to the freezer door 70. Accordingly, the Office Action has failed to meet the third factor set forth in Graham v. John Deere Co.

Finally, the photostand of claim 1 is detachably attached too the printer and can be used separately to display a photograph. The transparent panel of Zeligson is not detachable nor can it be separated from the freezer.

Regarding claim 2, as discussed during the interview, the combination of references does not disclose or suggest a photo stand that includes a frame in which a middle portion is open, a plurality of engaging protrusions provided on the rear surface of the frame, and engage respective engagement portions formed in the printer, and a photograph holding portion that is integrally formed to a base portion of each engagement protrusion.

The Office Action alleges that Zeligson teaches a photo stand and a photograph holding portion 81 that is integrally formed to a base portion of each engagement protrusion. However, reference number 81 corresponds to an adhesive means to attach a photograph, or other displays, to a freezer door. Thus, the attachment means 81 of Zeligson does not correspond to the photograph holding portion of claim 2, nor is such a photograph holding portion integrally formed to the base portion of the photo stand. Rather, the attachment means is merely adhered

to the surface of a freezer door 70. Thus, the combination of Zeligson and Pangburn does not disclose the features recited in claim 2, or the corresponding features recited in claims 8, 11-14 and 20. Accordingly, Applicants respectfully request the rejection of claims 1, 2, 8, 11-14 and 20 under 35 U.S.C. §103(a) be withdrawn.

IV. New Claims

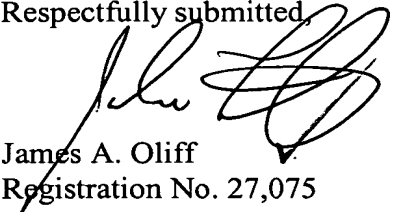
Applicants assert that claims 21 and 22 are allowable over the applied references of record. None of the references, whether considered alone or in combination disclose or suggest a printer with a photostand . . . wherein the photostand is detachably attached to engagement protrusions and includes an opening whose size is substantially the same size as a size of a photograph.

V. Conclusion

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1-22 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,


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